

### **REMARKS**

Applicant has carefully reviewed the Final Office Action mailed August 19, 2009 and offers the following remarks to accompany the above amendments.

#### ***Interview Summary***

Applicant thanks the Examiner for the courtesies extended during the telephonic interview conducted with the undersigned on October 15, 2009. The Examiner and the undersigned discussed the appropriateness of the finality of the present Office Action and potential amendments to claim 1 to overcome the rejection under section 101.

#### ***Finality of the Office Action***

Applicant respectfully submits that the finality of the Office Action is inappropriate in view of the new rejection of claim 61 under 35 U.S.C. § 101, and requests that the Patent Office withdraw the final status thereof. Applicant notes that the sole amendments to claim 61 in the Amendment filed on May 4, 2009 involved replacing the words "effecting selection" with "selecting" and the words "effecting delivery" with "delivering". In the present Office Action, the Examiner has opined that claim 61 "could be completely performed mentally, verbally or without a machine nor is any transformation apparent," and therefore is unstatutory.<sup>1</sup> Without conceding the appropriateness of this assertion, Applicant fails to see how this assertion applies any less to the previous version of claim 61. Thus, Applicant submits the present § 101 rejection was not necessitated by the amendment of claim 61, and thus the finality of the present office action is inappropriate and should be withdrawn.

#### ***Status of the Claims***

Claims 61-64, 66-70, and 72-92 were previously pending. No claims are added or cancelled herein. Claim 1 has been amended to clarify that the method is a computer-implemented method, and that it is performed on a processing device. This amendment is supported throughout the specification, including, for example, at paragraphs 18, 23, 24, and Figure 1. Accordingly, claims 61-64, 66-70, and 72-92 remain pending.

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<sup>1</sup> Office Action mailed August 19, 2009, p. 2.

Applicant requests entry of this amendment because the amendment does not raise new issues that would require a new search or consideration. Applicant notes that the Patent Office has already searched for electronically performed methods as is readily apparent from the prior art cited in the subject application. Moreover, the amendment does not raise new matter, because the amendment is supported by at least the referenced portions of the specification discussed above. The amendment does place the application in better form for appeal by simplifying the issues – specifically, the amendment eliminates the issue of the § 101 rejection.

***Rejection Under 35 U.S.C. § 101 – Non-Statutory Subject Matter***

Claim 61 was rejected under 35 U.S.C. § 101 as not falling within one of the four statutory categories of an invention. The Patent Office opines that “claim 61 is non-statutory since it is not requisitely tied to another statutory class and it does not requisitely transform underlying subject matter to [a] different state or thing.”<sup>2</sup> Applicant has amended claim 1 to clarify that the method is a computer-implemented method, and to explicitly recite that the steps of comparing the user profiles and selecting a matching user profile are performed on a processing device. Applicant submits that it necessarily follows that the steps of selecting a playlist of a matching user associated with the matching user profile is necessarily performed on a processing device, as is delivering the playlist to the media player device, which could only be performed electronically. Thus, Applicant respectfully submits that claim 61 is statutory, and requests that the rejection be withdrawn.

***Rejection Under 35 U.S.C. § 103(a) – Chislenko and Chang***

Claims 61-64, 66-70, 75, 77-81, 85, 87-90, and 92 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,041,311 to Chislenko et al. (hereinafter “Chislenko”) in view of U.S. Patent Application Publication No. 2002/0168938 A1 to Chang (hereinafter “Chang”). Applicants respectfully traverse. When determining whether a claim is obvious, an Examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*,

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<sup>2</sup> *Id.* at pp. 2-3.

490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Chislenko discloses a system wherein items in a category, or “domain,” may be recommended to a user of the system based on similarities of the rating of such items by the respective user and the rating of such items by a group of “neighboring users” of the system (Chislenko, col. 3, ll. 6-14; col. 8, ll. 1-18; col. 9, ll. 39-48). Chislenko discloses that the group of neighboring users of the system may be determined, at least in part, by “comparing that user’s profile with the profile of every other user of the system” (*Id.* at col. 5, ll. 51-55). Applicant notes, however, that the profiles in Chislenko are compared not to select a user from which the system can obtain a playlist, but to determine what other users rate items similarly, i.e., to determine the group of “neighboring users” (*Id.* at col. 8 ll. 1-18). Applicant’s claimed invention, in contrast, compares profiles to determine a “matching user” and to select a playlist of the matching user. Chislenko fails to teach or suggest selecting a matching user. Chislenko likewise fails to teach or suggest selecting a playlist of a matching user, and delivering the playlist to the media player device.

The Patent Office concedes that Chislenko fails to disclose selecting a playlist of a matching user associated with a matching user profile (Office Action mailed August 19, 2009, p. 4). However, the Patent Office asserts that Chang discloses these limitations. Applicant respectfully disagrees. Chang relates to coordinated and synchronized music playback among peer devices (Chang, Abstract). Chang discloses a system wherein user profiles may comprise lists of songs (*Id.* at para. 21). If a list of songs of one user is sufficiently similar to a list of songs of another user, the system disclosed in Chang may determine that a profile match exists (*Ibid.*). A song that is common to both lists may then be played concurrently on each of the user devices associated with the users (*Id.* at para. 24). Therefore, Chang does not compare each of a plurality of user profiles with a target user profile, because there is no plurality of user profiles with which a comparison can be made. Consequently, neither Chislenko nor Chang teach or suggest this limitation. Moreover, Chang does not disclose a separate profile and a separate playlist, as recited in Applicant’s claims – rather Chang discloses a profile that comprises a list of songs. Because the profile is the list of songs, Chang cannot disclose first selecting a matching

user profile from a plurality of user profiles and then selecting a playlist of a matching user. Nowhere does Chang disclose that subsequent to a match of user profiles a playlist of a matching user is selected and delivered to the media player device. Rather, Chang teaches playing the same song that the user already has identified in their respective profile. In this regard, Chang teaches away from selecting and delivering a playlist to the media player device associated with the target user. This is because Chang is not concerned with locating and delivering playlists to a user. Rather, Chang is concerned with synchronized playback of a song on two devices. Applicant submits that combining the teachings of Chang with Chislenko would result in a system wherein a user of the system in Chislenko is recommended the same items that the user already rated highly. This would be inconsistent with the teachings of Chislenko, and therefore Applicant submits one would not be motivated to combine the teachings of Chang with Chislenko. However, even if the teachings of Chang were combined with those of Chislenko, neither Chislenko nor Chang, either alone or in combination, teach or suggest selecting a playlist of a matching user associated with a matching user profile and delivering the playlist to a media player device associated with a target user profile, as recited in Applicant's claim 61. Applicant's claims 78 and 89 contain similar limitations, and therefore submit that Applicant's claims 61, 78, and 89 are not rendered obvious by Chislenko and Chang, and respectfully request that the rejection be withdrawn.

Claims 62-64, 66-70, 75, 77, 79-81, 85, 87, 88, 90, and 92 depend directly or indirectly from claims 61, 78, and 89, respectively. As such, claims 62-64, 66-70, 75, 77, 79-81, 85, 87, 88, 90, and 92 are allowable for at least the same reasons set forth above with respect to claims 61, 78, and 89. Therefore, Applicant respectfully requests that the rejection be withdrawn. However, Applicant reserves the right to further address the rejection of claims 62-64, 66-70, 75, 77, 79-81, 85, 87, 88, 90, and 92 in the future, if needed.

#### ***Rejection Under 35 U.S.C. § 103(a) – Chislenko, Chang, and Elliott***

Claims 72, 82, and 91 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chislenko in view of Chang and in further view of U.S. Patent Application Publication No. 2005/0165888 A1 to Elliott (hereinafter “Elliott”). Applicants respectfully traverse. The standards for obviousness are set forth above.

Claims 72, 82, and 91 depend directly or indirectly from claims 61, 78, and 89, respectively. As such, claims 72, 82, and 91 are allowable for at least the same reasons set forth above with respect to claims 61, 78, and 89. However, Applicant reserves the right to further address the rejection of claims 72, 82, and 91 in the future, if needed.

***Rejection Under 35 U.S.C. § 103(a) – Chislenko, Chang, and Mercer***

Claims 73 and 83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chislenko in view of Chang and in further view of U.S. Patent Application Publication No. 2004/0078382 A1 to Mercer et al. (hereinafter “Mercer”). Applicants respectfully traverse. The standards for obviousness are set forth above.

Claims 73 and 83 depend directly or indirectly from claims 61 and 78, respectively. As such, claims 73 and 83 are allowable for at least the same reasons set forth above with respect to claims 61 and 78. However, Applicant reserves the right to further address the rejection of claims 73 and 83 in the future, if needed.

***Rejection Under 35 U.S.C. § 103(a) – Chislenko and Shirwadkar***

Claims 74 and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chislenko in view of U.S. Patent Application Publication No. 2004/0162830 A1 to Shirwadkar (hereinafter “Shirwadkar”). Applicant respectfully traverses. The standards for obviousness are set forth above.

Claims 74 and 84 depend directly or indirectly from claims 61 and 78, respectively. As such, claims 74 and 84 are allowable for at least the same reasons set forth above with respect to claims 61 and 78. However, Applicant reserves the right to further address the rejection of claims 74 and 84 in the future, if needed.

***Rejection Under 35 U.S.C. § 103(a) – Chislenko, Chang, and Sakuma***

Claims 76 and 86 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chislenko in view of Chang and in further view of U.S. Patent Application Publication No. 2006/0256669 A1 to Sakuma et al. (hereinafter “Sakuma”). Applicants respectfully traverse. The standards for obviousness are set forth above.

Claims 76 and 86 depend directly or indirectly from claims 61 and 78, respectively. As such, claims 76 and 86 are allowable for at least the same reasons set forth above with respect to claims 61 and 78. However, Applicant reserves the right to further address the rejection of claims 76 and 86 in the future, if needed.

### ***Conclusion***

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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